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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/046,019	01/11/2002	Jean-Francois Courtoy	78200-040	5197

7590 12/30/2004

Norris, McLaughlin & Marcus, P.A.  
721 Route 202-206  
P.O. Box 1018  
Somerville, NJ 08876-1018

EXAMINER

VO, HAI

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 12/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/046,019

Applicant(s)

COURTOY ET AL.

Examiner

Hai Vo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-30, 33, 37-45, 47, 50-52, 54 and 56-58 is/are pending in the application.
- 4a) Of the above claim(s) 1-30 and 37-45 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 33, 47, 50-52, 54, and 56-58 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to, See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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1. The double patenting rejections and the art rejections over Courtoy et al (Re 33, 599) in view of Chen et al (US 6,555,216) are considered moot in view of the claim cancellation.
2. The indicated allowability of claims 33, 47, 50-52, 54, 56-58 is withdrawn in view of the 112 claim rejections; first paragraph and Brossman et al (US 6,613,256) as evidenced by Eby et al (US 5,961,903); therefore, the finality of that action is withdrawn.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 33, 47, 50, 51, 54, and 56-58 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claims recited the portion of the cured layer coating disposed over the optional second ink is chemically embossed; however, the recitation is not fully supported in the present specification. Nowhere in the specification discloses that the cured layer over the first ink is chemically embossed.

***Claim Rejections - 35 USC § 102***

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5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 33, 47, 50-52, 54, and 56-58 are rejected under 35 U.S.C. 102(e) as being anticipated by Brossman et al (US 6,613,256) as evidenced by Eby et al (US 5,961,903). It is noted that the second ink and the third ink are not required by the claims and therefore any limitations associated with them are completely excluded from the claims. Brossman makes it clear that the non-foamed regions correspond to "down areas" or "depressed areas" of the chemical embossing whereas the foamed regions correspond to "up areas" or "raised areas" of the chemical embossing. Therefore, the down areas of the cured coating layer disclosed by Brossman is chemically embossed. Brossman teaches a surface covering comprising a substrate, a foamed plastic layer overlying the substrate, an ink containing a photoinitiator printed in a design on the foamed plastic layer, a cured coating layer overlying the foamed plastic layer and the ink wherein the portion of the cured coating layer disposed over the ink is mechanically embossed with a surface texture having relatively deep emboss depths as compared with a matting grain, wherein the portion of the cured coating layer which is not disposed over the ink is mechanically embossed with a second mechanically embossed texture different from the first

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mechanically embossed texture (claim 3). Brossman discloses a top coat of polyurethane overlaying the cured coating layer (column 7, lines 29-30). Brossman uses an embossing roll similar to that in US 5,961,903 to mechanically emboss the wear layer (example 4). Eby teaches the wear layer is mechanically embossed with a surface texture of wood, stone, marble or brick (column 2, lines 40-43). Therefore, it is not seen that the wear layer in the Brossman could not have a surface texture of wood, stone, marble or brick when the same embossing roll is employed. It is the examiner's position that Brossman anticipates the claimed subject matter.

### ***Conclusion***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai Vo whose telephone number is (571) 272-1485. The examiner can normally be reached on M,T,Th, F, 7:00-4:30 and on alternating Wednesdays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (571) 272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>.

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Should you have questions on access to the Private PAIR system, contact the  
Electronic Business Center (EBC) at 866-217-9197 (toll-free).

HV

Hai Vo  
Tech Center 1700